

RECEIVED
CENTRAL FAX CENTER

APR 27 2006

Withrow & TerranovaProfessional Limited Liability CompanyAttorneys At LawRegistered Patent Attorneys*A High Technology Patent Practice*

FACSIMILE TRANSMITTAL SHEET

TO:	FROM:
Examiner: Greg Bengzon	Benjamin S. Withrow
COMPANY:	DATE:
USPTO - Art Unit 2144	04/27/2006
FAX NUMBER:	TOTAL NO. OF PAGES INCLUDING COVER:
571-273-8300	11
PHONE NUMBER:	SENDER'S REFERENCE NUMBER:
	7000-091
RE:	YOUR REFERENCE NUMBER:
Reply Brief	09/973,412

☐ URGENT ☐ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ ORIGINAL TO FOLLOW

NOTES/COMMENTS:

Please find attached the following item(s):

- 1) Reply Brief (10 pages).

NOTE: The information contained in this transmission is privileged and confidential and intended ONLY for the individual or entity named above. If you should receive this transmission in error, please notify our office and return to the below address via the U.S. Postal Service.

201 SHANNON OAKS CIRCLE, SUITE 200

CARY, NC 27511

PH: (919) 654-4520

FAX: (919) 654-4521

RECEIVED
CENTRAL FAX CENTER

APR 27 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Paul T. Brescia

Serial No. 09/973,412

Filed: 10/09/2001

For: **LOCATION-BASED ADDRESS PROVISION**

Examiner: Bengzon, Greg

Art Unit: 2144

Mail Stop Appeal Brief -- Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

A **REPLY BRIEF** is filed herewith. If any fees are required in association with this reply brief, the Director is hereby authorized to charge them to Deposit Account 50-1732, and consider this a petition therefor.

REPLY BRIEF**A. Introduction**

In its Appeal Brief, Appellant argued that: (1) claims 39 and 47 are definite under 35 U.S.C. § 112, second paragraph; (2) claims 39-43, 46-51 and 54 are non-obvious over Owensby in view of Heddaya because the Patent Office has not shown a proper motivation to combine the references to arrive at the claimed invention and even if combined, the combination does not establish *prima facie* obviousness; and (3) claims 44, 45, 52, and 53 are non-obvious over Owensby in view of Heddaya, and further in view of Guedalia because the Patent Office has not shown a proper motivation to combine the references to arrive at the claimed invention.

B. Argument**1. Claims 39 and 47 Are Definite under 35 U.S.C. § 112, Second Paragraph**

With respect to Appellant's first argument, that claims 39 and 47 are definite under 35 U.S.C. § 112, second paragraph, Appellant notes that the Examiner did not address this rejection or Appellant's arguments relating to this rejection in the Answer. Perhaps the Examiner is withdrawing this rejection. In the event such rejection is not withdrawn, Appellant refers the Board to its arguments in its initial Appeal Brief as to why claims 39 and 47 are definite under 35 U.S.C. § 112, second paragraph. (See Appeal Brief, pp. 4 and 6-7).

2. Claims 39-43, 46-51 and 54 Are Non-Obvious Over Owensby in View of Heddaya**a. The Patent Office Has Not Shown a Proper Motivation to Combine the References to Arrive at the Claimed Invention**

In the Examiner's Answer, the Patent Office states that Owensby disclosed providing localized information to the wireless terminal and disclosed using the Internet as a medium for doing so. (Owensby, col. 1, lines 40-45). The Patent Office cites Heddaya as disclosing providing localized information (Heddaya, col. 3, lines 25-35) to the wireless terminal, using URLs and TCP/IP (*Id.*, col. 6, lines 45-55). The Patent Office then states that a person of ordinary skill in the art such as Owensby would have been motivated to look for more detailed disclosures regarding presentation of internet content to a wireless terminal as disclosed by Heddaya. (Examiner's Answer, p. 13). This asserted motivation to combine Owensby and

Heddaya is different than the motivation previously advanced by the Examiner.¹ Since the Examiner's motivation to combine (i.e., to look for more detailed disclosures regarding presentation of internet content to a wireless terminal) has changed, the newly offered evidence may be considered a new ground of rejection in the Examiner's Answer that is prohibited by MPEP § 1208.01, which states that 37 C.F.R. § 1.193(a) prohibits the entry of a new ground rejection in an Examiner's answer. At the very least, it speaks to the difficulty Examiner is having with finding a proper basis to combine the Owensby and Heddaya references.

Nevertheless, Appellant addresses the newly stated motivation to combine Owensby and Heddaya. The newly stated motivation to combine Owensby and Heddaya does not create the advantage advanced by the Patent Office as part of the rationale to combine the references. There must be some suggestion to combine references in an obviousness rejection. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The Patent Office states that the motivation is to look for more detailed disclosures regarding presentation of internet content to a wireless terminal. However, the Patent Office states that Owensby disclosed providing localized information to the wireless terminal and disclosed using the Internet as a medium for doing so. The Patent Office adds that Heddaya discloses providing localized information to the wireless terminal, using URLs and TCP/IP. It is not clear why one of skill in the art having Owensby's teaching would need or look to Heddaya, if the only thing Heddaya adds is URLs and TCP/IP, especially if one of ordinary skill in the art was trying to reach the claimed invention, including the limitation of "establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed."

In addition, the Examiner provides no actual evidence to support this newly stated motivation to combine Owensby and Heddaya. While the required motivation can come from a variety of sources, the range of sources does not diminish the requirement for actual evidence in support of the stated motivation. *In re Dembiczak*, 175 F.3d at 999. Since the stated motivation is not supported by actual evidence, the motivation is improper. Since the motivation is

¹ The Patent Office's previously suggested motivation to combine Owensby and Heddaya was that:

"... it would have been obvious to a person of ordinary skill in the art to implement the offloaded customization concepts as taught by Heddaya into the method and apparatus of Owensby, such that content may be customized and be made unique according to the location of the intermediate node. The suggested motivation for doing so would have been, as Heddaya suggests, to distribute the servicing of requests across multiple intermediate or secondary servers, such server being closer to the requesting user (by number of hops and distance), such that response time is faster and less network traffic is created. (See Heddaya, Columns 4 Lines 1-10)." (Office Action mailed April 26, 2005, page 7, lines 3-11).

improper, the combination is improper. Since the combination is improper, the rejection under 35 U.S.C. §103(a) should be withdrawn.

As further evidence that the combination of references is non-obvious, the combination makes Heddaya unsuitable for its intended purpose. (See Appeal Brief, p. 9.) In the Examiner's Answer, the Patent Office responds that "Heddaya is well-suited for the purpose of associating internet protocol addresses with unique content, and providing location specific unique content" and that "Heddaya disclosed a system that allows for a cellular client to access a content server (the closest by proximity) based on the location of the cellular client." (Examiner's Answer, p. 14, citing Heddaya, col. 2, lines 50-60). The Patent Office concludes by stating that Heddaya is not limited to spoofing and does not provide any suggestions that would make Heddaya unsuitable for wireless networks such as Owensby. First of all, as discussed in the Appeal Brief and again below, Applicant disagrees that Heddaya is well-suited for associating IP addresses with unique content, since Heddaya does not teach or disclose "establishing a plurality of unique IP addresses from each of which unique content may be accessed" or "associating each of the plurality of unique IP addresses with different geographic locations." Second, the portion of Heddaya cited by the Patent Office (col. 2, lines 50-60) is not the invention of Heddaya, but the background art discussed by Heddaya.² As such, the Examiner's citation to the background is not relevant to whether the combination makes Heddaya unsuitable for its intended purpose or whether the combination of Owensby and Heddaya is proper and teaches or suggests each and every element of the claimed invention. Finally, the Patent Office's conclusory statement that "Heddaya's disclosure is not limited to providing 'spoofing', and does not provide any suggestions that would make Heddaya unsuitable for wireless networks such as Owensby" is also irrelevant and does not rebut or even address Appellant's argument that the combination makes Heddaya unsuitable for its intended purpose. (Examiner's Answer, p. 14, line 6).

Appellant never said Heddaya was limited to spoofing, but argued that assuming that content is customized according to the location of the intermediate node, this change in the content vitiates Heddaya's purpose of providing proxy intermediate nodes that spoof the client into believing that the proxy is the desired server. (Appeal Brief, p. 9). That is, Heddaya states that "as part of fulfilling service requests at the intermediate locations, the client nodes are sent appropriate messages, depending upon the communication protocol in use, to 'spoof' the client

² The background section of Heddaya is discussed from col. 1, line 10 through col. 3, line 41.

nodes into believing that the services were actually provided by the primary server node.” (Heddaya, col. 4, lines 10-15). A particular example that becomes non-functional is the news server described by Heddaya. (Heddaya, col. 10, line 48 through col. 11, line 29). Once the content diverges between the various nodes, the mobile agent of Heddaya no longer knows how to intercept messages and reroute requests to the closest server. The Patent Office has failed to rebut this point in its Answer. By rendering Heddaya unsuitable for its intended purpose, the combination of references is non-obvious. Since the combination of references is non-obvious, the Patent Office has not established obviousness, and the claims are allowable.

3. The Combination Does Not Establish *Prima Facie* Obviousness

Even if the combination of Owensby and Heddaya is proper, a point which Appellant does not concede, the combination does not teach or suggest all the claim elements as required to establish *prima facie* obviousness.

a. “. . . establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed . . .”

In particular, independent claim 39 recites “establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed. . . .”³ In response to Appellant’s detailed arguments in its Appeal Brief that the combination of Owensby and Heddaya does not teach or suggest this element, the Patent Office responds with the old axiom that one cannot show nonobviousness by attacking the individuals individually when the rejection is based on a combination of references. Appellant of course understands this rule of law, but repeats its arguments in the Appeal Brief that neither of the references teaches or suggests the element of “establishing a plurality of unique internet protocol addresses from each of which unique content may be accessed.” (See Appeal Brief, pp. 10-12) Since the references individually do not teach or suggest the claim element, the combination of the references cannot teach or suggest the claim element.

The only other statement the Patent Office makes in its Answer is that Heddaya discloses using URLs to provide links to internet content and that a URL inherently provides a unique IP address from each of which unique content may be accessed. As support, the Patent Office cites

³ The other independent claim, claim 47, recites essentially the same element allowing for differences between method and apparatus claims.

Heddaya, col. 1, lines 40-50. Once again, this citation is from the background section of Heddaya and merely discloses how a typical URL works in the context of the Internet and within the HTTP protocol. Appellant is not trying to claim a URL; Appellant's claim 39, as an example, claims a method of providing content to a mobile terminal user based on a location of the mobile terminal with one step being "establishing a plurality of unique IP addresses from each of which unique content may be accessed, wherein said unique content is location specific." As discussed in its Appeal Brief, on p. 12, Appellant argued that Heddaya does indicate that internet protocols can be used, but there is no indication that this is for accessing unique content from cellular phones, as is asserted by the Patent Office. In short, Appellant repeats its observation that merely because there is the mention of the terms "URL", "Internet", or "TCP/IP", there is not necessarily a teaching of establishing unique internet protocol addresses from each of which unique content may be accessed, as recited in the claims.

Moreover, Appellant notes that the Examiner has failed to provide any evidence showing the alleged inherency, as required by MPEP § 2112. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *Id.*, citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis in original). The Examiner here has failed to offer any such basis to support that the allegedly inherent characteristic – establishing a plurality of unique IP addresses from each of which unique content may be accessed, wherein said unique content is location specific – necessarily flows from the disclosure of a URL. Since the Examiner has failed to offer any evidence to support the alleged inherency, the alleged teaching of the claim element is not supported. Since the Heddaya reference does not teach the claim element, the claim is not obvious over the combination of Heddaya and Owensby.

b. "...associating each of the plurality of unique internet protocol addresses with different geographic locations ..."

Appellant further argues that the combination does not teach "...associating each of the plurality of unique internet protocol addresses with different geographic locations. ..." as recited

in claim 39.⁴ As stated above with respect to section 3a, the Patent Office responds with the old axiom that one cannot show nonobviousness by attacking the individuals individually when the rejection is based on a combination of references. However, the claim element must be found in one of the cited references before the combination can teach or suggest the claim element. The Patent Office does not cite to any new portion of the references, but relies on Owensby, col. 22, lines 45-55, as allegedly teaching providing links to localized information, said localized information dependent on the location of the mobile terminal (Examiner's Answer, p. 15). As set forth in its Appeal Brief on p. 13, Applicant stated that Owensby, col. 22, lines 35-65 does state "information provided to the subscriber may vary based on the geographical location of the subscriber at the time that the inquiry, response or request is made."⁵ However, there is no association of each of the unique internet protocol addresses with different geographic locations as recited in the claim. Merely because the passage states that information may vary based on the location of the subscriber does not mean that the passage teaches or suggests that internet protocol addresses are associated with different geographic locations. Indeed, there is no indication that the information of the passage is associated with any internet protocol address. Rather, the information is inserted into the call. The passage is silent as to the storage mechanism that contains the information, or how the information is accessed such that it is inserted into the call. Thus, this passage does not teach the recited claim element.

Owensby, col. 23, lines 1-25 also describes that the call record may track "the geographical location of the subscriber at the time the advertisement was inserted. . ."⁶, but the passage is again silent as to how the advertisement is located or tracked. Specifically, there is no teaching or suggestion in the passage that each of the unique internet protocol addresses are associated with different geographic locations, as recited in the claims.

Thus, Owensby does not teach or suggest the claim element. Likewise, the Patent Office has not identified anything in Heddaya that shows the claim element. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination cannot teach or suggest the claim element, the combination does not establish obviousness.

⁴ Claim 47 has essentially the same element allowing for differences between method and apparatus claims.

⁵ Owensby, col. 22, lines 48-52.

⁶ Owensby, col. 23, lines 1-3 and 13-16.

4. Claims 41 and 49 Are Separately Patentable

Appellant also argued in its appeal Brief that claims 41 and 49 are separately patentable because the claimed step of “allowing access to the content when the mobile terminal uses the identified address” is not taught or suggested by the combination of Owensby and Heddaya. The Patent Office responds in the Examiner’s Answer⁷ that Heddaya, at col. 1, lines 40-45, discloses that to access internet content, a URL must be provided, and that since Owensby is intent on providing internet content (Owensby, col. 1, lines 40-45) to the mobile terminal in addition to the initial advertisement message, it would have been obvious to use a URL in the advertisement as a means to provide the link (back to the subscriber) (Owensby, col. 6, lines 15-20). First, the Patent Office has not complied with *In re Dembiczak* by providing the requisite stated motivation, and actual evidence supporting the stated motivation, to combine the references to reach the claimed invention of claims 41 and 49. In addition, this response ignores the fact that the subscriber in Owensby has no need to link back to the advertiser, because, as pointed out by Appellant on p. 15 of the Appeal Brief, the subscriber has already received the content and then gets supplemental information from the representative. Moreover, even if the subscriber in Owensby did use a URL as disclosed by Heddaya in the advertisement to provide a link back to the advertiser, that would not be equivalent to the claimed “allowing access to the content when the mobile terminal uses the identified address,” wherein the identified address is identified from among the plurality of unique IP addresses, as is required in claims 41 and 49, as they depend from claims 39 and 47, respectively.

5. Claims 42, 43, 50, and 51 Are Separately Patentable

Appellant also argues in its Appeal Brief that claims 42 and 50 are separately patentable because the step of “delivering the content to the mobile terminal in response to a request from the mobile terminal using the identified address” is not taught by Owensby, nor is the claimed step taught or suggested by the combination of Owensby and Heddaya. (Appeal Brief, p. 16). The Patent Office does not address these arguments. Likewise, the Patent Office does not address Appellant’s arguments that claims 43 and 51 are separately patentable because the combination does not teach “receiving a trigger initiated by an action of the mobile terminal as a

⁷ The Examiner says that its response is directed to Appellant’s arguments regarding claims 42 and 50, but it is clear from the body of the answer that Examiner is responding to Appellant’s arguments regarding claims 41 and 49.

condition of determining the current location of the mobile terminal.” Therefore, Appellant relies on its arguments on p. 16 of its Appeal Brief with respect to claims 42 and 50, and relies on its arguments on pp. 16-17 of the Appeal Brief with respect to claims 43 and 51. Since the combination of Owensby and Heddaya does not teach or suggest each and every element of claims 42, 43, 50, and 51 these claims are allowable.

6. Claims 44, 45, 52, and 53 Are Non-Obvious Over Owensby in view of Heddaya and further in view of Guedalia

Appellant notes that the Patent Office did not address its arguments that claims 44, 45, 52, and 53 are allowable because the Patent Office has not properly supported the motivation to combine Owensby, Heddaya, and Guedalia with the required evidence. Appellant therefore relies on its argument on p. 17 of its Appeal Brief with respect to this argument. Since the motivation lacks the requisite evidentiary support, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection based on the combination is improper, and the Patent Office has not established obviousness of claims 44, 45, 52, and 53.

C. Conclusion

The Patent Office has not shown that the claims are indefinite. Likewise, the Patent Office has not satisfied the Federal Circuit’s requirements relating to combining the references and thus the combinations of references are improper. Even if the combinations of references are proper, the combinations do not teach or suggest the claimed invention. For these reasons, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims.

<p align="center">CERTIFICATE OF TRANSMISSION</p> <p>I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:</p> <p>Examiner: <u>Bengzon, Greg</u> Art Unit: <u>2144</u> Fax: <u>571-273-8300</u></p> <p><u>Jennifer Allare</u> Name of Sender</p> <p><u>Jennifer Allare</u> Signature</p> <p><u>April 27, 2006</u> Date of Transmission</p>
--

Respectfully submitted,
WITHROW & TERRANOVA, P.L.L.C.

By:



Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520

Date: April 27, 2006
Attorney Docket: 7000-091